

REMARKS

In response to the Office Action dated October 15, 2004, Applicant respectfully requests reconsideration based on the following remarks. Applicant respectfully submits that the claims as presented are in condition for allowance.

Claims 1 and 3-7 were rejected under 35 U.S.C. § 103 as being unpatentable over Nolting in view of Lesley and Casner.

According to exemplary embodiments, a call is established and a set activation fee is charged only after the billing information has been confirmed. This set activation fee helps defray the cost of providing service to a PSTN to remote locations. For example, claim 1 recites "providing a dial tone to the set activation fee telephone from the public switched telephone network if the billing information is valid." In exemplary embodiments, no dial tone is provided until the billing information is confirmed. In fact, a false dial tone may be generated (Applicant's specification, page 3, lines 7-10) which is then released and replaced with a dial tone once the billing information is approved (Applicant's specification, page 3, lines 7-10).

Nolting allows the calls to be placed from a set activation fee phone and then attempts to track or identify such calls based on statistics. Column 30, lines 10-39 describes analyzing volume and duration of calls to detect calls to calling card numbers and then charging the set activation fee based on such calls. Thus, Nolting does not validate billing information, as acknowledged by the Examiner.

The Examiner relies on Lesley for determining if billing information is valid prior to placing a telephone call. The Examiner notes that Nolting and Lesley do not teach seizing a true dial tone once billing information is valid and relies on Casner for this feature. Applicant asserts that the proposed combination Casner, Lesley and Nolting would not be operative and thus, the proposed combination is not proper under 35 U.S.C. § 103.

In applying Nolting, the Examiner relies on column 30, lines 10-39, which relates to phone calls made from pay phones. The system of Lesley places a call from a set activation fee pay telephone in order to confirm that the user has account with sufficient funds to place a call. Alternate embodiments allow a user's home or business device to be pre-designated as a prepay phone, but a pay phone would not be pre-designated as it is not associated with

any one user. Thus, Lesley needs an actual dial tone in order for the user to dial a prepay network service telephone number. Therefore, the false dial tone of Casner would not be effective in Lesley as an actual call is needed to confirm prepaid billing information for a set activation fee pay phone in Lesley.

For the above reasons, the proposed modification to Lesley would render Lesley unsatisfactory for its intended purpose. As noted in MPEP § 2143.01, if proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Thus, the Examiner has failed to raise a *prima facie* case of obviousness.

Furthermore, the system of Casner is related to capturing billing information for calls placed from a PBX. Neither Nolting nor Lesley mention PBX and it is not clear why one of ordinary skill would combine features from a PBX billing system (i.e., Casner) into systems for managing payment of PSTN calls. Casner generates a PBX dial tone until user station identifier is entered so the call can be tracked to a user's station. Such a feature would limit Nolting and Lesley to PBX applications which is clearly not the intent of Nolting and Lesley. Thus, it would not have been obvious to combine Casner with Nolting and Lesley as proposed by the Examiner.

For at least the above reasons, claim 1 is patentable over Nolting in view of Lesley and Casner. Claims 3-7 depend from claim 1 and are patentable over Nolting in view of Lesley and Casner for at least the reasons advanced with reference to claim 1.

Claims 23 and 24 were rejected under 35 U.S.C. § 103 as being unpatentable over Nolting in view of Casner. Claim 23 recites "prior to placing the telephone call to the called telephone number, determining whether billing information for the telephone call is valid." Nolting fails to teach determining whether payment information is valid prior to placing the call. Nolting allows the calls to be placed from a set activation fee phone and then attempts to track or identify such calls based on statistics. Column 30, lines 10-39 describes analyzing volume and duration of calls to detect calls to calling card numbers and then charging the set activation fee based on such calls. Thus, Nolting does not validate billing information, as acknowledged by the Examiner.

The system of Casner is related to capturing billing information for calls placed from a PBX. Nolting does not reference PBX and specifically references PSTN calls from pay phones. Casner generates a PBX dial tone until a user station identifier is entered so the call can be tracked to a user's station. Such a feature would limit Nolting to PBX applications which is clearly not the intent of Nolting.

Further, there is no suggestion in Nolting to validate billing information prior to placing a call. Nolting approaches the problem by tracking calls and determining statistically whether calls are associated with a set activation fee pay phone. There is no teaching or suggestion in the references to combine Nolting and Casner as proposed by the Examiner. Thus, it would not have been obvious to combine Casner with Nolting and Lesley as proposed by the Examiner.

For the above reasons claim 23 is patentable over Nolting in view of Casner. Claim 24 depends from claim 23 and is patentable over Nolting in view of Casner for at least the reasons advanced with reference to claim 23.

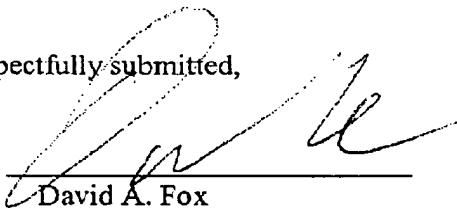
New claim 26 recites "determining whether the billing information is valid includes determining if an account is active, without determining the funds available." This is clearly distinct from pre-pay systems such as Lesley. New claim 27 recites adding the set activation fee and the charge for the telephone call to a customer bill. This feature is not taught in Nolting as the customer is not billed the 20 or 25 cents referenced in Nolting.

In view of the foregoing remarks, Applicant submits that the above-identified application is now in condition for allowance. Early notification to this effect is respectfully requested.

If there are any charges with respect to this response or otherwise, please charge them to Deposit Account 06-1130 maintained by Applicant's attorneys.

Respectfully submitted,

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